

R E M A R K S

Information Disclosure Statements

The Examiner is respectfully requested to return a copy of the IDS Form filed on July 31, 2009, and to indicate thereon that the cited publication was considered and made of record.

Restriction Requirement

Restriction was required under 35 USC 121 to (i) elect a single disclosed species from either of

16-phenoxy-15-deoxy-15,15-difluoro-17,18,19,20-tetranorprostaglandin F2 $\alpha$ ;

16-(3-chlorophenoxy)-15,15-difluoro-17,18,19,20-tetranorprostaglandin F2 $\alpha$ ; or

16-phenoxy-15-deoxy-15,15-difluoro-13,14-dihydro-17,18,19,20-tetranorprostaglandin F2 $\alpha$

and (ii) identify all the claims reading on the elected species.

It was stated in the Office Action that claim 10 is generic.

Applicants elect the following compound:

16-phenoxy-15-deoxy-15,15-difluoro-17,18,19,20-  
tetranorprostaglandin F2 $\alpha$ .

The claims readable on the elected compound are claims 10 to 13.

The Restriction Requirement concerning an election of a species is respectfully traversed on the ground that it is not a species requirement of the type set forth in MPEP 803.02 entitled "MARKUSH CLAIMS." It is respectfully submitted that the practice set forth therein and in the decisions cited in MPEP 803.02 are the proper practice to be applied in the present case and to the extent that the Restriction Requirement is not consistent therewith, it is respectfully traversed.

If, however, the Restriction Requirement is maintained, then taking into consideration that there is a generic claim, it is respectfully requested that the provisions of 37 CFR 1.141(a) and the procedure set forth in MPEP 806.04(d) be followed, which provide that once a claim that is determined to be generic is allowed, applicants will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of the allowable generic claim.

Reconsideration is respectfully requested.

If the Examiner has any comments, questions, objections or recommendations, the Examiner is invited to telephone the undersigned at the telephone number given below for prompt action.

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RSB/ddf

Respectfully submitted,



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